

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Atty. Docket .

Barry Scheirer et al.

US040176US

Int'l Appln. No.: PCT/IB2005/050987

Int'l File Date: 03/22/2005

Title: INTERCAVITY PROBE WITH CONTINUOUS SHIELDING
OF ACOUSTIC WINDOW

Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

PETITION WHEN INVENTOR REFUSES TO SIGN DECLARATION

Sir:

It is respectfully requested that the Commissioner permit the filing of this application with a Declaration unsigned by one of the five co-inventors, Alan Hornberger, who refuses to sign the Declaration signed by his four co-inventors. The underlying facts are as follows.

1. When Mr. Hornberger began his employment with Echo Ultrasound in 1988 he executed an agreement in which he agreed to assign inventions made during his employment to the company. See paragraphs (a) and (b) of the attached EMPLOYEE INNOVATION AND PROPRIETARY INFORMATION AGREEMENT. Mr. Hornberger renewed this obligation when Echo Ultrasound became a part of Philips Electronics as shown in paragraph 3 of the enclosed "Employee Ethics and Intellectual Property Agreement."

2. On December 16, 2003 Mr. Hornberger left the employ of Philips as shown by the enclosed "Affirmation of Confidentiality Agreement." On February 20, 2004 Mr. Hornberger's co-inventors submitted an invention disclosure that led to the filing of the present application. This invention disclosure named Mr. Hornberger as a co-inventor

based upon his contributions to the invention prior to his departure from Philips. A provisional application substantially identical to and the basis for the present application was filed on April 2, 2004 as serial number 60/559,388.

3. Around the time of filing of the provisional application one of Mr. Hornberger's co-inventors contacted him to ask him to sign the Declaration for this application. Mr. Hornberger refused the request.

4. On September 6, 2006 my assistant sent Mr. Hornberger a copy of the Declaration for this and another application and asked him to sign and return them. A copy of this letter is enclosed. The return receipt postcard from this mailing, a copy of which is enclosed, shows that the Declaration was received at Mr. Hornberger's last known address on September 13, 2006. A signed Declaration has not been returned by Mr. Hornberger. If it is, the undersigned will promptly submit it in this application. In the meantime, it is respectfully requested that this application be allowed to proceed with the Declaration signed all of the co-inventors except for Mr. Hornberger.

5. Please charge Deposit Account no. 14-1270 for the petition fee required by 37 CFR §1.17(g).

Respectfully submitted,

By: /W. Brinton Yorks, Jr./
W. Brinton Yorks, Jr.
Reg. No. 28,923

Philips Electronics
22100 Bothell Everett Highway
P.O. Box 3003
Bothell, WA 98041-3003
(425) 487-7152
September 19, 2006

ECHO ULTRASOUND

P.O. Box 552
Lewistown, PA 17044

EMPLOYEE INNOVATION AND PROPRIETARY INFORMATION AGREEMENT

To be completed in triplicate. Distribution: original copy to Personnel for the employee's folder; second copy to the employee; and third copy to Department Head.

TO ECHO ULTRASOUND:

In consideration of my employment by Echo Ultrasound and of the salary or wages paid to me, I agree:

- (a) to disclose and assign to the Company as its exclusive property, all inventions and technical or business innovations developed or conceived by me solely or jointly with others during the period of my employment, (1) that are along the lines of the businesses, work or investigations of the Company or its affiliates to which my employment relates or as to which I may receive information due to my employment, or (2) that result from or are suggested by any work which I may do for the Company or (3) that are otherwise made through the use of Company time, facilities or materials;
- (b) to execute all necessary papers and otherwise provide proper assistance (at the Company's expense), during and subsequent to my employment, to enable the Company to obtain for itself or its nominees, patents, copyrights, or other legal protection for such inventions or innovations in any and all countries;
- (c) to make and maintain for the Company adequate and current written records of all such inventions or innovations;
- (d) upon any termination of my employment to deliver to the Company promptly all items which belong to the Company or which by their nature are for the use of Company employees only, including, without limitation, all written and other materials which are of a confidential nature relating to the business of the Company or its affiliates;
- (e) not to use, publish or otherwise disclose (except as my Company duties may require), either during or subsequent to my employment, any confidential information or data of the Company or any information or data of others which the Company is obligated to maintain in confidence; and
- (f) not to disclose or utilize in my work with the Company any confidential information of others or any inventions

or innovations of my own which are not included within the scope of this agreement.

This agreement supersedes and replaces any existing agreement between the Company and me relating generally to the same subject matter. It may not be modified or terminated, in whole or part, except in writing signed by an authorized representative of the Company. Discharge of my undertakings in this agreement shall be an obligation of my executors, administrators, or other legal representatives or assigns.

I represent that, except as stated below, I have no agreements with or obligations to others in conflict with the foregoing.

(TYPE OR PRINT IN INK, USING FIRM PRESSURE)

Full Name ALAN G. HORNBERGER ECHO ULTRASOUND
Social Security No. 161-52-3230 Lewistown, Pennsylvania

Lisa A. Wagner
Witness (The employee's immediate superior or other appropriate representative of the Company)

(Signed) Alan G. Hornberger
(Employee's signature - to include employee's first name in full.)

BULLET'S COORDINATOR
Position

(Date) 12/5/89

Will P. Munn
Countersigned - Company President

The following are the only agreements to which I am a party, which may be in conflict with the obligations undertaken above:



Employee Ethics and Intellectual Property Agreement

In consideration of my accepting or continuing work at Philips Electronics North America Corporation or any of its divisions, subsidiaries or affiliates, (which will individually and collectively be called "the company") during such time as may be mutually agreeable, and in consideration of the salary or wages paid to me, I agree:

1. Not to use, publish or otherwise disclose (except as my job requires) either during or after my employment, any secret or confidential (proprietary) information or data of the company or its customers or any other third party received by the company in confidence.
2. Upon the termination of my employment, to deliver promptly to the company all written and other materials that relate to the business of the company or its affiliates.
3. To disclose promptly and agree to assign, without further compensation, to the company or its nominee as its exclusive property, all those inventions, and technical or business innovations (including works of authorship) developed or conceived by me alone or with others, while I am employed, which:
 - (a) pertain to any line of the businesses, work or investigations of the company or affiliates, (b) pertain to any demonstrably anticipated business, research or development of the company or its affiliates, (c) are suggested by or result from work that I may do for the company, or (d) are aided by use of time, materials, facilities, patents, trade secrets, know-how, technology, confidential information, ideas, copyrights, trademarks, and service marks and any and all rights, applications and registrations relating to them of the company.
4. To make and maintain for the company adequate and current written records of such inventions.
5. To perform all reasonable acts (such as execution of all necessary papers) and otherwise provide proper assistance (at the company's expense) during and subsequent to my employment to enable the company to obtain for itself or its nominees patents, copyrights or other legal protection for such inventions or innovations in any and all countries.
6. Not to disclose or utilize in my work any proprietary information of others (including that of any prior employers) or any inventions or innovations of my own which are not included within the scope of this agreement.

I have read and understood the Philips Electronics North America Corporation "Working Together" book. In consideration of my continuing employment with the company, I agree to abide by the ethical and legal principles of the company as they are incorporated in this book. I understand that failure to do so may result in the termination of my employment.

This agreement supercedes and replaces any Employee Ethics and Intellectual Property Agreement previously executed by me. It may not be modified or terminated, in whole or in part, except in writing signed by an authorized representative of the company.

I certify that to the best of my knowledge and belief, I am not a party to any other agreement or subject to any conflict of interests that will interfere with my full compliance with this agreement, except as specifically identified below. I understand that this agreement does not constitute a contract of employment, either express or implied.

ALAN HORNBERGER

PRINT NAME

Alan G. Hornberger 4-16-03 James D. Zimmerman 4-16-03
 EMPLOYEE'S SIGNATURE DATE WITNESS (Company Representative) DATE

I represent that the following are the only agreements, relationships and matters to which I have an interest that may conflict with the obligations I have undertaken above. I further agree to promptly notify my supervisor in writing of any change in this information.

If employed in any of the following states: California, Delaware, Illinois, Kansas, Minnesota, North Carolina, Utah or Washington, employees should also sign the relevant paragraph of the Employment Invention Attachment on the back of this agreement.

Philips Electronics
North America



PHILIPS

Let's make things better.



Affirmation of Confidentiality Agreement

Your termination does not end your continued obligations under the Employee Agreement you executed on the date that you were hired. These obligations include, without limitation, your agreement not to disclose or use (either directly or indirectly) any confidential information relating to the business of PHILIPS which was acquired by you from any source during your employment at PHILIPS. Such information includes (but is not limited to) know-how, formulae, trade secrets, designs, ideas, methods, processes and any other non-public information processes, future development, plans, strategies and operations, and business and financial data, including but not limited to customer lists, customer leads, price lists, discount structures, profits and product manuals.

In addition, you have continuing obligations to PHILIPS, as set forth in the Employee Agreement, with regard to ideas, discoveries and inventions, whether patentable or not, and other confidential information, made or conceived during your employment with PHILIPS.

If you have any questions concerning the nature or extent of your obligations under the aforementioned Employee Agreement, please call John Skrypak, Counsel, at (212) 536-0830.

ALAN G. HORNBERGER

Employee's Printed Name

Alan G. Hornberger

Employee's Signature

12-16-03

Date

Lisa A. Kennedy

Witness



PHILIPS

Philips Intellectual Property & Standards

September 6, 2006

VIA CERTIFIED MAIL
RETURN RECEIPT REQUESTED

Alan Hornberger
RR 2 Box 2685
McAlisterville, PA 17049

Re: Ultrasonic Probe Volume Compensation System
PH Ref No.: US040174
Intracavity Probe With Continuous Shielding of Acoustic Window
PH Ref No.: US040176
Documents for Signature

Dear Mr. Hornberger:

Would you please sign and date the enclosed sets of documents and return them to me in the enclosed self-addressed, stamped envelope by September 18, 2006. With the packet, I've included a copy of the relevant patent applications and drawings as previously approved by you.

Please let Brint Yorks know if you come across any information relative to these applications, such as issued patents or published patent applications or articles, or public presentations.

Thank you, and please let me know if you have any questions.

Cordially,

Jill Peistrup
Sr. Paralegal
jill.peistrup@philips.com
Tel: +1 425 487 7306
Fax: +1 425 487 8135

Enclosures

Is your RETURN ADDRESS completed on the reverse side?

SENDER:

- Complete items 1 and/or 2 for additional services.
- Complete items 3, 4a, and 4b.
- Print your name and address on the reverse of this form so that we can return this card to you.
- Attach this form to the front of the mailpiece, or on the back if space does not permit.
- Write "Return Receipt Requested" on the mailpiece below the article number.
- The Return Receipt will show to whom the article was delivered and the date delivered.

I also wish to receive the following services (for an extra fee):

1. ☐ Addressee's Address
2. ☐ Restricted Delivery

Consult postmaster for fee.

3. Article Addressed to:

Alan Hornberger
RR 2 Box 2685
McAlisterville, PA 17049

4a. Article Number

7099 3400 0014 5308 2841

4b. Service Type

- | | |
|---|---|
| <input type="checkbox"/> Registered | <input checked="" type="checkbox"/> Certified |
| <input type="checkbox"/> Express Mail | <input type="checkbox"/> Insured |
| <input type="checkbox"/> Return Receipt for Merchandise | <input type="checkbox"/> COD |

7. Date of Delivery

9-13-06

5. Received By: (Print Name)

8. Addressee's Address (Only if requested and fee is paid)

6. Signature: (Addressee or Agent)

X *Laury J. Adams*

PS Form 3811, December 1994

102595-88-B-0229

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Thank you for using Return Receipt Service.

U.S. Postal Service

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|---|-----------|---------------|
| Postage | \$ | \$2.07 |
| Certified Fee | | \$2.40 |
| Return Receipt Fee (Endorsement Required) | | \$1.85 |
| Restricted Delivery Fee (Endorsement Required) | | \$0.00 |
| Total Postage & Fees | \$ | \$6.32 |



Recipient's Name (Please Print Clearly) (to be completed by mailer)

Alan Hornberger

Street, Apt. No., or PO Box No.

RR 2 Box 2685

City, State, ZIP+4

McAlisterville, PA 17049

PS Form 3800, February 2000

See Reverse for Instructions

1492 9035 4100 004E 6602

UNITED STATES POSTAL SERVICE

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Permit No. G-10

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Ms. Jill Peistrup
Sr. Legal Assistant
Philips Intellectual Property & Standards
P. O. Box 3003
Bothell, WA 98041-3003

003 8300

